

In re Application of:
Rothstein et al.
Application No.: 09/695,795
Filed: October 23, 2000
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Attorney Docket No.: JHU1650-2

REMARKS

Claims 11, 13, 18-22, and 89-91 are pending and under examination in the present case. Claims 13 has been amended and claims 1-12, 14-17, 23-82, and 84-91 have been canceled herein without prejudice or disclaimer. Claims 92-93 have been added. Upon entry of this amendment, claims 13, 18-22, and 92-93 will be pending and under consideration.

No new matter is added with the amendments to the claims. The amendment to Claim 13 deletes certain previously pending claim language. Newly added claims 92 and 93 are supported by claim 13 as filed. The amendments do not require a new search or raise new issues for consideration because they merely address issues already raised by the Examiner or define Applicants' invention more clearly. It is submitted that the amendments place the claims in condition for allowance or in better condition for appeal by reducing the number of issues for consideration on appeal. The amendments were not made earlier in the prosecution because it is maintained that the previously pending claims were allowable. Since the amendments do not add new matter or require a new search or consideration, and place the claims in condition for allowance or in better condition for appeal, entry of the amendments and reconsideration of the application in view of the amendments herein are respectfully requested.

Claim Rejection Under 35 U.S.C. § 112, First Paragraph-Enablement

Claims 11, 13, 18-22, and 89-91 stand rejected under 35 U.S.C. § 112, first paragraph because the specification allegedly does not enable all polynucleotides encompassed by these claims. The Office Action acknowledges that the Applicants are in possession of the polynucleotide of SEQ ID NO:3 and polynucleotides encoding GTRAP4-48, SEQ ID NO:4. However, the Office Action asserts that the claims embrace an infinite number of polynucleotides encoding an infinite number of GTRAP polypeptides. Regarding claim 13, the Office Action asserts that claim 13 encompasses several layers of degeneracy, encompassing open "having" language, as well as claims using allegedly open language "wherein T *can be* U" (emphasis in original).

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While respectfully maintaining that the previously pending claims are enabled by the disclosure as filed, to expedite allowance of the present case, Applicants have canceled claims 11 and 89-91, thereby rendering the rejection of these claims moot. Regarding amended claim 13, all possible polynucleotides encompassed by the claim have a structure (i.e., a nucleotide sequence) that can be determined based solely on information in the disclosure and routine computations, without further experimentation. Since the amino acid sequence of SEQ ID NO:4 is disclosed, polynucleotides that encode this polypeptide can be readily identified using the well-known genetic code and routine computations. One of these sequences, SEQ ID NO:3, specifically recited in the claim, is disclosed in the application. Accordingly, claim 13 encompasses polynucleotides of known sequence, not an infinite number of polynucleotides, as alleged in the Office Action. Furthermore, claim 13 as amended in element b, encompasses a polynucleotide wherein T is U. From the readily identified sequences encoding SEQ ID NO:4, a skilled artisan will understand that these sequences can be readily transcribed to produce a polypeptide that encodes SEQ ID NO:4 wherein thymidine residues are uridine residues. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 11, 13, 18-22, and 89-91 under 35 U.S.C. § 112, first paragraph.

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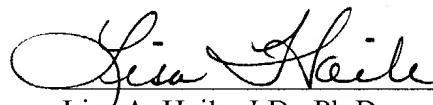
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If the Examiner believes that a telephonic or personal interview would be helpful to resolve any issues which may remain in the prosecution of the Application, the Examiner is requested to telephone Applicants' attorney at the telephone number set forth herein below.

The Commissioner is hereby authorized to charge any additional fees which may be required in the Application to Deposit Account No. 50-1355.

Respectfully submitted,



Dated: January 26, 2004

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